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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,622	06/16/2000	Geoffrey W. Simons	70655.8100	1037

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
2178	

2178

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No. 09/595,622	Applicant(s) SIMONS, GEOFFREY W.	
Examiner Cong-Lac Huynh	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 31 January 2007.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8, 11, 19, 20, 22, 23, 27, 28 and 36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8, 11, 19, 20, 22, 23, 27, 28 and 36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

1. This action is responsive to communications: response filed 1/31/07 to the application filed on 6/16/00.
2. Claims 1-8, 11, 19-20, 22-23, 27-28, 36 are pending in the case. Claims 1, 11, 19, 26, and 36 are independent claims.

Priority

3. Applicant submits that the provisional application of this case should be 60/139,654, not 60/159, 654. However, the limitations of claims 1-8, 11, 19-20, 22-23, 27-28, and 36 of this case are not disclosed in the provisional application filed 6/16/99. Specifically, the user profile or the form map are never mentioned in the provisional application. The priority, thus, is not proper. The effective date of the case, therefore, is 6/16/00.

Oath/Declaration

4. The declaration remains objected to since claiming of domestic priority is not proper and there is no correction of the claimed domestic priority.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 7,11, 27-28, 36 remain rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy et al. (US 6,651,217, filed 9/1/99).

Regarding independent claim 1, Kennedy discloses:

- creating a user profile associated with a user, wherein said user profile includes user data (figure 2, col 6, lines 19-37)
- obtaining an electronic form having a field to be completed (figures 2-3)
- dynamically generating a form map, wherein the form map identifies an association between the user data and the field in the electronic form (figure 2)
- obtaining the user profile from a fill server (figure 6: receiving files from server)
- completing the field according to the form map with the user data (figures 7-8)
- parsing the user data from the field to create field data (col 6, lines 50-61:extracting the user data from the field such as the name, address, and phone number entered by the user shows parsing the user data for field data to be extracted)
- comparing the field data to the corresponding user data in the user profile (col 6, lines 50-61: matching the field form with those in the autofill profile implies that a comparing of these data is performed)
- replacing the user data in the user profile with the field data, when the field data is different from the user data in the user profile (abstract, col 6, lines 38-61:

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missing data such as email, which is not in the user profile before and so is considered different from user data in the user profile, when being entered by user to the form, will be used as the basis for populating future form shows that user data in the user profile is replaced with the data entered by user)

Regarding claim 2, which is dependent on claim 1, Kennedy discloses that obtaining a user profile includes:

- transmitting a user identification and a signature of the electronic form to a fill server (figure 6, col 8, lines 22-45)
- obtaining the user profile from the fill server, wherein the user profile corresponds to the user identification (col 8, lines 22-65)

Regarding claim 3, which is dependent on claim 2, Kennedy discloses that the user identification includes a user ID and a user password (col 8, lines 22-45, col 10, lines 5-24).

Regarding claim 7, which is dependent on claim 1, Kennedy discloses that the user profile is represented by a graphical icon on a display screen and wherein the user data is transferred to the electronic form on manipulation of the graphical icon within the display screen (col 6, lines 19-37).

Regarding claim 11, which is dependent on claim 1, Kennedy discloses:

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- displaying a second application indicative of the user profile containing data corresponding to at least the field of the electronic form according to the form map (figure 2)

Regarding claim 27, which is dependent on claim 1, Kennedy discloses that the system further comprises a user information server in communication with the fill server and providing user profile data to the fill server (figure 2).

Regarding claim 28, which is dependent on claim 1, Markus discloses a form map server in communication with the fill server and providing form maps corresponding to at least one field of an electronic form, wherein a graphical representation includes a merger of the form map and the user profile data (figure 2).

Regarding independent claim 36, Kennedy discloses:

- creating a user profile associated with a user, wherein said user profile includes user data (figure 2, col 6, lines 19-37)
- obtaining an electronic form having a field to be completed (figures 2-3)
- dynamically generating a form map, wherein the form map identifies an association between the user data and the field in the electronic form (figure 2)
- obtaining the user profile from a fill server (figure 6: receiving files from server)
- completing the field according to the form map with the user data (figures 7-8)

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- parsing the user data from the field to create field data (col 6, lines 50-61: extracting the user data from the field such as the name, address, and phone number entered by the user shows parsing the user data for field data to be extracted)
- comparing the field data to the corresponding user data in the user profile (col 6, lines 50-61: matching the field form with those in the autofill profile implies that a comparing of these data is performed)
- replacing the user data in the user profile with the field data, when the field data is different from the user data in the user profile (abstract, col 6, lines 38-61: missing data such as email, which is not in the user profile before and so is considered different from user data in the user profile, when being entered by user to the form, will be used as the basis for populating future form shows that user data in the user profile is replaced with the data entered by user)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 4-6 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy et al. (US 6,651,217, filed 9/1/99).

Regarding claim 4, which is dependent on claim 2, Kennedy does not explicitly disclose that the electronic form signature includes a text string having a uniform resource locator of the electronic form.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kennedy to include the electronic form signature with text of a uniform resource locator of the electronic form since it is clear that the form belongs to a web page that has a uniform resource locator, which is the address of the web page. The address of the form, thus, should include the address of the web page to which it belongs.

Regarding claim 5, which is dependent on claim 4, Kennedy discloses that the electronic form signature includes a descriptor of the one or more fields of the electronic form (figures 3-4).

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Regarding claim 6, which is dependent on claim 4, Kennedy discloses that the electronic form signature includes a descriptor of form field requirements (figure 6).

10. Claims 8, 19-20, 22-23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy as applied to claim 1 above, and further in view of Markus et al. (US Pat No. 6,490,601 B1, 12/3/02, filed 1/15/99).

Regarding claim 8, which is dependent on claim 1, Kennedy does not disclose that the user profile includes shippable code embodying the user data corresponding to the fields of the electronic form, and wherein completing at least one of the fields of the electronic form includes executing the shippable code to complete at least one of the fields of the electronic form.

Markus discloses that the user profile includes shippable code embodying the user data corresponding to the fields of the electronic form, and wherein completing at least one of the fields of the electronic form includes executing the shippable code to complete at least one of the fields of the electronic form (col 5, lines 29-44).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Markus into Kennedy for incorporating the execution of the shippable code for completing at least one of the fields in the electronic form having multiple fields for entering data.

Regarding claim 19, which is dependent on claim 1, Kennedy does not disclose:

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- generating a fill bundle corresponding to a merger of data within at least one of the user profile and the form map corresponding to a form signature, wherein the fill bundle is embodied in a graphical representation

Markus discloses:

- generating a fill bundle corresponding to a merger of data within at least one of the user profile and the form map corresponding to a form signature, wherein the fill bundle is embodied in a graphical representation (figure 6, #608 Server merges mapping table with user's raw data profile, #610 Server converts merger into shippable code; col 13, line 49 to col 14, line 29: generating a shippable code in the form of a JavaScript program where the shippable code, converted from the merger of legacy bank name and raw data value associated with one of a plurality of users, is used to fill in the form on the user browser; the shippable code bundles data for filing the electronic form, and is corresponding to a fill bundle)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Markus into Kennedy since the fill bundle in Markus would provide the advantage to incorporate into the user profile and the form map in Kennedy for having in a package a form with the form signature and a related profile, for easily using.

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Regarding claim 20, which is dependent on claim 1, Kennedy does not disclose obtaining the user profile corresponding to a user identification from a database having one or more user profiles organized according to the user identification.

Markus discloses obtaining the user profile corresponding to a user identification from a database having one or more user profiles organized according to the user identification (figures 3A-B and col 8, lines 40-64: raw data profile contains sets of data relating to registered user of the privacy bank service where a registered user has a unique account number as a user identification).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Markus into Kennedy for classifying user profiles according to the user identification for quickly retrieving data.

Regarding claim 22, which is dependent on claim 1, Kennedy does not disclose that if the form map database does not have a form map corresponding to the form signature, generating a new form map based upon the form signature.

Markus discloses that if the form map database does not have a form map corresponding to the form signature, generating a new form map based upon the form signature (col 13, line 49 to col 14, line 4: the privacy bank server uses the URL or other identifier for the specific form to be filled out to retrieve a mapping of each field name in the electronic form to privacy bank standardized names; the merchant submits one or more forms to privacy bank which then examines each field name in the forms and matches it with a privacy bank field name; the fact that if the legacy name does not

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match the privacy bank field names, then the privacy bank user raw data *can be updated to* include the legacy name based upon the identifier of the form indicates that when the privacy bank server whose form map database does not have the form map of the newly submitted form from the merchant, the privacy bank raw data *is updated to include the newly created form map of the new form based upon the corresponding URL or the form signature*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Markus into Kennedy for obtaining a form map if such a map does not exist to facilitating the form filling process..

Regarding claim 23, which is dependent on claim 19, Kennedy does not disclose that the fill bundle includes shippable code containing commands for completing one or more corresponding fields of the electronic form.

Markus discloses that the fill bundle includes shippable code containing commands for completing one or more corresponding fields of the electronic form (col 14, lines 5-29: "normally browser programs have a JavaScript component that is manipulable by JavaScript commands. *These JavaScript commands in the shippable code are used to fill in the electronic form on the browser, a technique well known in the field of Internet and Java programming..*").

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Markus into Kennedy for easily completing fields of the electronic form via the fill bundle with at least a field with shippable code commands.

Response to Arguments

11. Applicant's arguments filed 1/31/07 have been fully considered but they are not persuasive.

Applicant argues that Kennedy does not qualify as prior art under 35 U.S.C. 102(e) since this case has a provisional application filed on 6/16/99 that predates the 9/1/99 filing date of Kennedy (Remarks, page 6).

Though having said provisional application, this case does not have the priority date since the limitations of the claims in the case are not disclosed in the provisional application. Thus, applicant fails to prove his possession of the claimed invention on the date of the provisional application. The effective date of this case, therefore, is the filing date of this case 6/16/00.

Applicant argues that Kennedy does not disclose or suggest "comparing the field data to the corresponding user data in the user profile" and "replacing the user data in the user profile with the field data, when the field data is different from the user data in the user profile" (Remarks, page 6).

Examiner respectfully disagrees.

Matching the field from with those in the autofill profile in Kennedy (col 6, lines 50-61) implies that data in the field form is compared to the corresponding user data in the profile to have a match.

In Kennedy (col 6, lines 38-61), missing data such as email, which is not in the user profile before and so is considered different from user data in the user profile, when

being entered by user to the form, will be used as the basis for populating future form. This shows that the user data in the user profile is replaced with the data entered by the user.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zhanhong Wu et al. (US 2002/0108057).

Mikurak (US 2004/0064351).

Kakehashi (US 6,959,414).

Holt et al. (US 7,051,273).

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Stiles et al. (US 6,842,737).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Primary Examiner
Art Unit 2178
04/02/07